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EXAMINER

SKAARUP, JASON M

ART UNIT PAPER NUMBER

3714

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/931,345

**Applicant(s)**

DAN ET AL.

**Examiner**

Jason Skaarup

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 14-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 14-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:

In paragraph [0039], the specification recites, "a body part corresponded to content to be transmitted having a text based keyword, a script language having a designated format or a combination thereof, and an accompanying file added information having various formats." The phrase "an accompanying file added information having various formats" is unclear to the Examiner. Appropriate correction is required.

### ***Claim Objections***

2. Claims 1, 3, 7, 19 and 23-26 are objected to because of the following informalities:

Claim 1 recites the limitation "a toy being inputted the message information" which is unclear. Applicant might replace the phrase "inputted the message information" with the phrase "inputted with the message information". Appropriate correction is required.

Claim 3 recites the limitation "an accompanying file added information having various formats". The phrase "an accompanying file added information having various formats" is unclear. Appropriate correction is required.

Claim 7 recites the limitation "toy operation data having an order set operating a certain motion of the motion database of the toy or timely variation/angle change data of

joints operable a direct operation joint and a rotation joint". The phrase "timely variation/angle change data of joints operable a direct operation joint and a rotation joint" is unclear. Appropriate correction is required.

Claim 19 recites the limitation "a microprocessor calculating a variation or an angle operable a toy" which is unclear. Appropriate correction is required.

Claim 23 recites the phrase "and a display unit, a speaker outputting the inputted message information" appears to include a typographical error. Applicant might replace the phrase "and a display unit, a speaker outputting the inputted message information" with the phrase ", a display unit and a speaker outputting the inputted message information". Appropriate correction is required.

Claim 24 recites the limitation "wherein the communication means is a PC or a mobile phone or a PDA". However, claim 19 recites the limitation "a wire-wireless communication means constructed with a PC or a mobile phone or a PDA". Therefore, claim 24 does not further limit claim 19 as required by 37 CFR 1.75(c). Appropriate correction is required.

Claim 25 recites the limitation "judging whether there is a designated message information in the interpreted message information". The phrase "there is" is unclear and Applicant might consider the limitation "judging whether the interpreted message information includes designated message information" as a possible replacement. Additionally, the phrase "there is" in the limitation "when there is the designated messaged information" is also unclear. Applicant might consider the limitation "when

designated messaged information is present in the interpreted message information” as a possible replacement. Appropriate correction is required.

Claim 26 recites the limitation “judging whether there is designated certain message information in the interpreted electronic mail information”. The phrase “there is” is unclear and Applicant might consider the limitation “judging whether the interpreted electronic mail information includes designated certain message information” as a possible replacement. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 4, 5 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation “outputting character information/audio information/image information corresponded to the inputted message information” which is vague and indefinite as the phrase “outputting character information/audio information/image information “ is unclear in reciting what information is being outputted.

Claim 4 recites the limitation “the designated script language” in line 2 thereof. There is insufficient antecedent basis for this limitation in this claim.

Claim 5 recites the limitation “the designated keyword” in line 2 thereof. There is insufficient antecedent basis for this limitation in this claim.

Claim 19 recites the limitation "the value" in line 10 thereof. There is insufficient antecedent basis for this limitation in this claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 and 14-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Gabai et al. (U.S. Patent No. 6,290,566).

Gabai et al. disclose an apparatus for operating toys through a computer communication (Figures 1A through 2C and 20 along with the related descriptions thereof). The disclosed apparatus comprises a communication server (server 1250) that supplies message information through a computer communication in a network (Figure 20 along with the related description thereof); an operation device (computer 100) interpreting the message information inputted from the communication server (server 1250); and a toy (toy 1260) inputted with the message information from the operation device (computer 100) and performing a certain motion or outputting character information/audio information/image information corresponded to the inputted message information (col. 13, lines 52-56, col. 14, lines 22-30 and col. 46, lines 20-25).

Gabai et al. teach that the operating device (computer 100) judges whether message information is received through a computer communication with communication server (server 1250). The operating device (computer 100) extracts and interprets the received message information from the communication server (server 1250) before communicating the same to the toy (toy 1260). Each toy (toy 1260) judges whether the message information received from the operating device (computer 100) includes designated messaged information (a script for performing an action) and performs a motion or speaking a word by operating a toy operation software when the designated messaged information is present in the interpreted message information (col. 13, lines 52-56, col. 14, lines 22-30 and col. 46, lines 20-25).

Regarding claim 14, Gabai et al. disclose that the operation device is a computer (Figure 20 along with the related description thereof).

Regarding claim 15, Gabai et al. disclose that the operation device (computer 100) includes a virtual character (animated object 165) performing a motion/audio in a cyber space corresponding to an actual toy (toy 122) performing motion/audio in a real space (Figure 2B along with the related description thereof) when inputted with message information from either the communication server (server 1250) or the operating device (computer 100).

Regarding claim 16, Gabai et al. disclose that the virtual character (animated object 165) and the actual toy (toy 122) operate interactively when a computer communication using the virtual character is performed (col. 15, line 56 to col. 16, line 3).

Regarding claim 17, Gabai et al. disclose that the toy is supplied experience information of the virtual character (animated object 165) or grows according to learning performed by a user, performs a motion and outputs character information, audio information and video information (Figures 35-43 along with the related descriptions thereof).

Regarding claim 18, Gabai et al. disclose that the toy performs motion/audio interactive with the virtual character (animated object 165) by being inputted motion/audio information of the virtual character from the operation device or transmitting the motion/audio information thereof to the virtual character (Figures 35-43 along with the related descriptions thereof).

Regarding claim 19, Gabai et al. disclose that the toy includes a memory (col. 48, lines 43-45 and col. 51, lines 17-21); an input/output means (140, 150), a wire-wireless communication means (antenna) and a microprocessor and operating unit (toy operation device 130). See Figure 1B along with the related description thereof.

Regarding claim 20, Gabai et al. disclose that the toy connects to the communication server (server 1250) without passing through the operation device (computer 100) and transmits and/or receives message information with the communication server (Figure 20 along with the related description thereof, wherein network computer 1270 allows connection between toy 1260 and the server 1250).

Regarding claim 21, Gabai et al. disclose that the memory includes a motion/audio database storing certain motions, character information, audio information



and video information (col. 14, lines 22-40 and Figures 35-43 along with the related descriptions thereof).


Regarding claim 22, Gabai et al. disclose that the motion/audio database is constructed with motion, action, operation of the power, voice, music, audio, character and pattern or combination thereof (col. 14, lines 22-40 and Figures 35-43 along with the related descriptions thereof).

Regarding claim 23, Gabai et al. disclose that the input/output means (140, 150) is constructed with a keyboard, a microphone, a sensor for inputting message information, a display unit, and a speaker outputting the inputted message information (col. 13, line 60 to col. 14, line 27).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8.  Claims 2-<sup>13</sup>~~14~~ and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabai et al. in view of Hachiya et al. (U.S. Patent No. 6,175,857).

Gabai et al. teach a virtual character (animated object 165) for performing a motion/audio in a cyber space that corresponds to an actual toy (toy 122) performing motion/audio in a real space (Figure 2B along with the related description thereof) as detailed above. Gabai et al. teach that the operating device (computer 100) inputs

message information to the virtual character (col. 15, line 56 to col. 16, line 3) to perform actions which are also performed by the actual toy (toy 122). Gabai et al. also teach that message information can be input to the actual toy (toy 122, 1260) via a communication server (server 1250). However, Gabai et al. does not explicitly teach that the communication server is an electronic mail server that supplies message information between users through electronic mails in a network as recited in claims 2-8 and 26-28. In a related remotely programmable toy, Hachiya et al. teach a mail server 11D that communicates script language via electronic mail for use by a programmable toy (virtual pet 103A through 103E) to perform actions based on the script language. The virtual pet performs motion/audio actions in accordance with designated message information (script language in the form of agent parameter 203 contained in electronic mail as shown in Figure 10 along with the related description thereof) when the electronic mail contains such script language. Electronic mail that does not contain designated message information is handled in a conventional manner (Figure 10 along with the related description thereof). It would have been obvious for one skilled in the art at the time of the invention to incorporate the electronic mail server of Hachiya et al. into the network taught by Gabai et al. to remotely program a virtual or actual toy in order to increase user excitement by allowing users to dynamically update actions performed by the toy.

Regarding claims 3, 4, 5, 6 and 8, Hachiya et al. teach an electronic mail address of a sender and a recipient, a body part corresponding to a content to be transmitted having a script language of a designated format and an accompanying file, which the

message information uses in operation of the toy (Figures 4-6 along with the related descriptions thereof).

Regarding claim 7, Hachiya et al. teach that the MIME type accompanying file format includes a header (201) and toy operation data (203D) including toy audio/sound data (Figures 6 and 7 along with the related descriptions thereof).

Regarding claims 27 and 28, Hachiya et al. teach extracting and interpreting designated message information (script language in the form of agent parameter 203 contained in electronic mail as shown in Figure 10 along with the related description thereof) from the body part and from the execution file of the electronic mail message information (col. 8, lines 25-65).

### ***Conclusion***


9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is listed on the attached Notice of References Cited (PTO-892). Specifically, Brown (WO 99/17854) could have been used to reject at least claims 1 and 25 under Section 102(b), as Brown discloses remotely programming a toy via downloadable scripts for toy action from a server.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jason Skaarup whose telephone number is 571-272-4455. The Examiner can normally be reached on Monday-Thursday (10:00-8:00).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Jessica Harrison can be reached at 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to be 'JH' followed by a long horizontal stroke.

**JESSICA HARRISON  
PRIMARY EXAMINER**